



DAE # / JFW

Docket No.: 1760.1001

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

Shigeo YAGUCHI

Serial No. 10/748,234

Group Art Unit: 3773

Confirmation No. 7113

Filed: December 31, 2003

Examiner: BUI, VY Q

For: INTRAOCULAR DEVICE FOR RETAINING A LENS CAPSULE

**APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 35 U.S.C. § 154 (B)(1) and 37 C.F.R. § 705**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

**INTRODUCTION**

Petition is hereby made to adjust the patent term of the patent-to-issue for the above-referenced application based on the below facts.

The Petition fee of \$200 set by 37 C.F.R. § 1.18(e) is submitted herewith.

The patent-to-issue on this application is not the subject of any terminal disclaimer.

Pursuant to Rule 1.705(b)(2)(iv)(B), Applicant is not aware of any circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the above-referenced application as set forth in Rule. 1. 704.

**FACTS**

A first Notice of Allowance was mailed on April 29, 2010 indicating that claims 22, 24, 25, 28 and 31-34 were allowed, providing certain "Reasons for Allowance", and indicating a Patent Term Adjustment date of 1071 days.

The issue and publication fees were paid July 14, 2010.

A "Notice of Withdrawal from Issue Under 37 C.F.R. 1.313" was mailed July 18, 2010.

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This notice was issued only at the initiative of the PTO. No reason was provided in the Notice as to why the application was withdrawn from issue, even though the issue fee had been paid, contrary to MPEP § 1308 II. 2.

When the undersigned contacted the Examiner, the undersigned was advised informally that the application was withdrawn due to a question whether there was support in the application as filed for the claim term "blunt."

After consideration of the application by the Examiner and his supervisor, a second Notice of Allowance was mailed on June 10, 2011 without any changes being made to the application, including the earlier allowed claims 22, 24, 25, 28 and 31-34, and confirmation that the subject term was fully supported by the application as originally filed, i.e., "each tip has a blunt free terminus as shown in F 1 to avoid puncturing the capsule as described in section [0043]."

This second Notice of Allowance still indicated, notwithstanding the PTO's removal of the application from issue on its own initiative for about 11 months, and a conclusion that the reason for withdrawal was unfounded, the Patent Term Adjustment date of 1071 days.

## **REQUEST FOR ADJUSTMENT**

It is respectfully requested that the patent term be adjusted at least to include the days extending from one day after the date that is four months after the issue fee was paid on July 14, 2010 to the date the patent issues, pursuant to 37 C.F.R. § 1.703 (a)(6), which issue date has not been set yet since the issue fee has not been paid in response to the second Notice of Allowance. Of course, this application for patent term adjustment must be filed prior to or with the payment of the issue fee. 37 C.F.R. 1.705 (b).

## **DISCUSSION**

Section 154(b)(1) of the Patent Act provides a day-by-day patent term adjustment if the PTO fails, within specified time periods, to:

... (4) issue a patent within four months after the date on which the issue fee was paid ... and all outstanding requirements were satisfied...

In the present case the issue fee was paid on July 14, 2010. All outstanding requirements were met on that date: Applicant was not thereafter requested, and has not needed, to fulfill any requirements. As noted above, the second Notice of Allowance allowed the same claims as the first Office Action without any amendments being required therein.

The USPTO may take the position that if prosecution in an application is reopened after allowance (see M.P.E.P. § 1308), all outstanding requirements are not satisfied until the application is again in condition for allowance as indicated by the issuance of a new notice of allowance. See Horwitz, *Patent Office Rules and Practice*, Rule 703, page 39-33, with August 2011 Supp., Lexis/Nexis Publishers. While this position may be applicable if, during the withdrawal a requirement is made and Applicant fulfills same, it shouldn't apply when, like here, there was never an outstanding requirement for Applicant to fulfill.

More particularly, regardless of the reason for the withdrawal of this application from issue, there were no outstanding requirements at the time the first Notice of Allowance issued, when the Notice of Withdrawal issued, or even up to the time the second Notice of Allowance issued. As noted above, the claims were allowed in the first Notice of Allowance, almost eleven months of withdrawal passed, and the second Notice of Allowance issued, with no substantive Office Action in between, no voluntary or responsive amendments were made to the application, including the claims. As noted above, the claims as allowed in the second Notice of Allowance are identical to those in the first. Thus, for whatever reason the application was withdrawn from issue, the Examiner and his supervisor concluded on re-examination that there was no reason to withhold the application from issue, that there were no outstanding requirements, and merely issued a second Notice of Allowance confirming the first Notice of Allowance. Under such circumstances, the Applicant should not have to bear the loss of term.

If Applicant does not recover at least some of this delay caused by the PTO, there is no limitation on the PTO withdrawing any application from issue for any period of time and merely returning it to issue without any requirements being raised, needed or fulfilled. This clearly would be inconsistent with the purposes of the Patent Term Guarantee Act of 1999 which created 35 U.S.C. § 154 (b).

## **SUMMARY**

The above-referenced application was withdrawn from issue at the PTO's sole initiative,

without stating any reason on the record, the application sat in limbo for about 11 months, and the application was merely re-allowed without any requirements being set or any changes being made to the application, all to the detriment of Applicant who has unnecessarily lost patent term. It is respectfully submitted that this lost time in withdrawal be reinstated by way of an appropriate patent term adjustment.

Respectfully submitted,

STAAS & HALSEY LLP

Date: \_\_\_\_\_

8/23/11

By: \_\_\_\_\_

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